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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/689,656

10/22/2003

Mikhail Kejzelman

003301-054

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06/27/2007

BUCHANAN, INGERSOLL & ROONEY PC

POST OFFICE BOX 1404

ALEXANDRIA, VA 22313-1404

EXAMINER

KESSLER, CHRISTOPHER S

ART UNIT

PAPER NUMBER

1742

MAIL DATE

DELIVERY MODE

06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,656

Applicant(s)

KEJZELMAN ET AL.

Examiner

Christopher Kessler

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-30, 34-40 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-30, 34-40, and 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 April 2007 has been entered.

Status of Claims

2. Responsive to the amendment, claim 30 is amended in order to correct the dependency. Claims 20-30, 34-40, and 48-51 are currently under examination.

Status of Prior Rejections

3. The rejection of claim 30 under 35 U.S.C. 112 as being unclear has been overcome by amendment. The rejection of claim 49 under 35 U.S.C. 112 is withdrawn. The rejections based on the prior art are maintained.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1742

5. Claims 20-30, 34-38, 40 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki et al (hereafter "Ozaki").

Ozaki is applied to the claims as stated in a prior Office Action. With regard to amended claim 30, the prior rejection is still applicable.

6. Claims 39, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki et al. in view of Rutz et al.

Ozaki and Rutz are applied to the claims as stated in a prior Office Action.

Response to Arguments

7. The rejection of claim 49 under 35 U.S.C. 112 is withdrawn. Applicant's arguments filed 19 April 2007 with regard to the prior art have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., surface finish) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant has stated that Ozaki teaches adding 0.75% lubricant, outside the range of claim 1. While the Examiner agrees with this statement, Ozaki also teaches an example with 0.2 parts lubricant added to 100 parts iron using powder A1, as was cited

in the Office Action of 19 October 2006. The previously cited portion of Ozaki thus anticipates claim 20.

In the Remarks of 19 April 2007, Applicant states at page 10:

Applicants have determined that if the particle size fraction less than 45 μm is removed, a considerably lower ejection force is achieved as shown in Figure 1-2. Ozaki shows examples with a high fraction of particle size below 150 μm and consequently large amounts of particles sized below 45 μm .

As was cited in the Office Action of 19 October 2006, Ozaki discloses wherein less than 2% of the particles are 150 μm (powder A1, for example). While Ozaki shows examples with greater than 90% of particles less than 150 μm , such as powders A12 and A13, these examples are explicitly stated in Ozaki to be **comparative examples** based on conventional practices (see cols. 6-7, Table 1, for example). Ozaki also explicitly discloses that these examples yield a **lower density** than the powder compositions with powder size meeting the range of the instant claims (see Table 1, for example). This Ozaki does not teach away from Applicant's invention. Ozaki discloses a process meeting the limitations of the instant claims, as was stated in the prior Office Action. Applicant is further directed to MPEP 2123. The lack of disclosure of any other particular problems caused by the powders containing more fine particles is thus moot.

In regard to the argument regarding internal v. external lubrication, Ozaki teaches wherein zinc stearate is added to the powder, which is then compacted at 1177 MPa, as was cited in the Office Action of 19 October 2006.

In response to applicant's argument that there is no motivation to use the powders of Rutz at compaction pressure of 800 MPa, such a modification of the practice

Art Unit: 1742

of Rutz was not suggested by the Examiner. Instead, the Examiner stated in the Office Action of 19 October 2006 that Rutz offers teachings that would make it obvious to use warm compaction and to use a fully alloyed iron composition for the powder in the invention of Ozaki. The motivations for altering the invention of Ozaki were stated in that action as well.

In response to applicant's argument that Rutz does not show an improved surface finish, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1742

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Kessler whose telephone number is (571) 272-6510. The examiner can normally be reached on Mon-Fri, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

csk


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